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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,643	10/05/2001	Yoichi Ozawa	210090US0PCT	4356

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EXAMINER	
PADEN, CAROLYN A	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/868,643	OZAWA ET AL.	
	Examiner	Art Unit	
	Carolyn A Paden	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) *4-13 and 15-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5,6,9,10* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicant's election with traverse of Group I in Paper No. 14 is acknowledged. The traversal is on the ground(s) that there is a unity of invention between Groups I to III because there is a technical relation that involves the same special technical feature. This is not found persuasive because the special technical feature does not contribute over the prior art and thus no single general inventive concept exists. Therefore, restriction is appropriate. Applicant argues the features of claim 3 but examiner does not have to pick a dependent claim for a technical feature. Applicant's invention is supposed to be set forth in claim 1.

Applicant urges that examiner has not followed the rules with regard to making a requirement for lack of unity of invention. This is disagreed with. The groups are listed and a reference was provided to show that there is no single general inventive concept.

Applicant urges that no lack of unity of invention was made in the International Preliminary Examination. This is disagreed with as shown in Sheet B of the International Authority. The International examination did not have the extra burden of performing a search and examination under US Patent laws. The method of making the soybean material produces a product that has more components in it

than soybean oil has. Also the utility of the soybean oil in lowering cholesterol is not a specific characteristic of soy oil or soybeans in general.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kin (Japanese 11-196803). Applicant draws equivalence between soybean germ and soybean embryo in the difference in the title utilized in paper 14 and paper 7.

Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kim (5,952,230).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,952,230) in view of Smith.

Kim discloses the mechanical separation of soybean embryos from the rest of the soybeans by splitting the soybeans and separating the embryos from the rest of the bean. The soybeans are processed to create a mixture of hulls and embryos (see abstract) and then figure 1 shows that the hulls are removed to leave the embryos. The final product is stated to contain 20% embryo. Although soybean germ is not specifically mentioned in the reference, applicant draws equivalence between soybean germ and soybean embryo in the titles submitted in papers 6 and 10. Thus soybean germ is considered to be equivalent to soybean embryo. The claims appear to differ from the reference in the suggestion that flaking is used in the process. Smith teaches at figure 9.14 that flaking is a known process step that occurs after cracking and dehulling. Thus with the reference before him, it would have been obvious, at the time the invention was made, to utilize the flaking step of Smith to further process the soybean embryos of Kim to create a flaked soy food

product. Kim may or may not be using a specific portion of the soybean but to flake all or only part of the soybean is not alone seen to constitute unobviousness.

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kin (Japanese 11-196803). Applicant draws equivalence between soybean germ and soybean embryo in the difference in the title utilized in paper 14 and paper 7.

Kin discloses crushing soybeans to break the soybeans in half. Then the embryos are separated from the rest of the soybeans by the differences in the specific gravity of the soybeans and the embryos. The final product is stated to contain 10-20% embryo. Although soybean germ is not specifically mentioned in the reference, applicant draws equivalence between soybean germ and soybean embryo in the titles submitted in papers 6 and 10. Thus soybean germ is considered to be equivalent to soybean embryo. The claims appear to differ from the reference in the suggestion that flaking is used in the process. Smith teaches at figure 9.14 that flaking is a known process step that occurs after cracking and dehulling. Thus with the reference before him, it would have been obvious, at the time the invention was made, to utilize the flaking step of Smith to further

process the soybean embryos of Kin to create a flaked soy food product. Kin may or may not be using a specific portion of the soybean but to flake all or only part of the soybean is not alone seen to constitute unobviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is 703-308-3294. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Carolyn Paden

CAROLYN PADEN 6-26-03
PRIMARY EXAMINER
GROUP ~~1300~~ 1761